

Application No. 10/716,869
Attorney Docket No. 3177 P 526
Reply to Office Action Mailed May 13, 2005

REMARKS

Status of the Application

Claims 1-35 are pending in the present application. By this amendment, claims 36-38 have been added. Thus, claims 1-38 are currently at issue.

Objections to the Drawings

In paragraph 1 of the Office Action, the Examiner objected to the drawings as failing to comply with 37 C.F.R. §1.84(p)(4). The Examiner stated that reference character “24” has been used to designate both the straw opening and the game piece. Applicants respectfully submit that reference character “24” has been used consistently throughout the drawings to designate the game piece, and not the straw opening. The straw opening is only visible in FIGS. 1 and 6, where it is designated by reference numbers “22” and “22 (prime)” respectively. Should the Examiner disagree, Applicants respectfully request the Examiner to specifically point out the Figures in which the reference numbers have been used inconsistently.

Claim Rejections Under 35 U.S.C. § 102

Rejections over Strange

In paragraph 3 of the Office Action, the Examiner rejected claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,056,144, to Strange et al. (“Strange”). Applicants respectfully traverse the Examiner’s rejection.

In order for a reference to constitute a §102(b) bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983). The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *Ex Parte Levy*, 17 U.S.P.Q. 2d 1461 (BPAI 1990) (“it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.”); *In re Lange*, 209 U.S.P.Q. 288 (CCPA 1981) (in order to anticipate, the reference must describe or disclose all of the limitations of the claims). It is well-settled law that the burden of establishing

a *prima facie* case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

Claim 1 includes, among other things, “a raised central plateau adapted to receive a promotional game piece.” Applicants respectfully submit that Strange does not disclose this element of claim 1. Strange discloses a locking lid for a beverage cup that attaches to the cup more securely due to a unique arrangement of protuberances on the inner side of the lid. (See Strange, col. 1, lines 24-55). The lid (10) contains a central dome portion (12) that extends across the major portion of the lid’s overall diameter. (See Strange, col. 2, lines 63-65). Although the structure of the dome (12) of Strange is not generally discussed within the specification, discussion can be made with reference to the Figures. Strange does not disclose “a raised central plateau adapted to receive a promotional game piece.” Even assuming for the purpose of argument that the dome (12) of Strange could be considered a “raised central plateau,” as the Examiner asserts, there is no disclosure in Strange that the dome (12) is adapted to receive a promotional game piece. (See, e.g., Strange, FIGS. 4-5). In fact, there is no discussion or suggestion of any promotional game piece anywhere in Strange. Thus, Strange does not disclose this element of claim 1, and does not anticipate claim 1.

Claim 1 also includes, among other things, “said central plateau including a circumferential beveled segment over which a tab of the game piece may extend.” As discussed above, Strange does not disclose or suggest the use of a game piece in connection with the disclosed lid. As such, Strange does not disclose any structure over which a tab of a game piece may extend. Further, Strange does not disclose a “circumferential beveled segment.” Contrary to the Examiner’s assertions, the wall depending from the dome (12) into the trough (near reference number “18”) is neither “beveled,” nor a “segment.” The depending wall of Strange angles downwardly from the dome (12) and does not appear to contain any variation in angle, and therefore, is nothing more than a circumferential side wall. (See Strange, FIGS. 4-5). The plateau (16) of the present application also contains such a circumferential side wall (16-2) depending into a trough (18). (See par. [0019] – [0020], FIGS. 3-4). However, the specification and claims of the present application clearly differentiate between this side wall (16-2) and the beveled segment (16-3). As can best be seen with reference to FIGS. 3-5 of the present

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application, the beveled segment (16-3) is only a portion of this side wall (16-2), and is angled differently with respect to the rest of the side wall (16-2). Strange discloses no such structure since, as described above, the side wall of Strange contains no variations. Thus, Strange does not disclose this element of claim 1, and does not anticipate claim 1.

Claims 2-11 depend from claim 1 and contain all the limitations of claim 1. Thus, for the reasons set forth above with respect to claim 1, Strange does not anticipate claims 2-11.

Rejections over Reidinger

In paragraph 4 of the Office Action, the Examiner rejected claim 14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,311,860, to Reidinger et al. (“Reidinger”). Applicants respectfully traverse the Examiner’s rejection.

Claim 14 includes, among other limitations, “a promotional game piece affixed to said lid so as to cover said recessed well in spaced relationship to said bottom wall thereof.” Applicants respectfully submit that Reidinger does not disclose this element of claim 14. Reidinger discloses a lid (30) that contains a recessed well (44) configured to receive a game piece (54), which is then covered by a sealing member (60) to retain the game piece therein. (See Reidinger, col. 4, lines 45-47; col. 5, lines 17-20). Reidinger does not disclose a game piece that is either affixed to the lid or that covers the recessed well. On the contrary, the game piece (54) in Reidinger lies flat within the recessed well (44) and is contained therein by the presence of the sealing member (60). (Reidinger, col. 4, lines 45-51; col. 5, lines 17-24). Therefore, Reidinger discloses the opposite of the claimed structure, *i.e.*, that the game piece is received within the well, rather than to cover the well. It is the sealing member (60) of Reidinger that covers the recessed well (44), and not the game piece (54). There is no other disclosure or suggestion in Reidinger to affix a promotional game piece to the lid so as to cover the recessed well. Thus, Reidinger does not disclose this element of claim 14, and does not anticipate claim 14.

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Claim Rejections Under 35 U.S.C. § 103

Rejections over Strange in view of Reidinger

In paragraph 6 of the Office Action, the Examiner rejected claims 12, 13, 15-22, and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over Strange in view of Reidinger. Applicants respectfully traverse the Examiner's rejections.

To establish a *prima facie* case of obviousness, all the elements of the claimed invention must be disclosed, taught, or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981).

Claim 12 expressly incorporates all the elements of claim 1 therein. Accordingly, claim 12 includes, among other things, "a raised central plateau adapted to receive a promotional game piece." As discussed above with respect to claim 1, Strange does not disclose or suggest this element. Applicants respectfully submit that Reidinger also does not disclose or suggest this element. Reidinger discloses a lid (30) that contains a recessed well (44) configured to receive a game piece (54), which is then covered by a sealing member (60) to retain the game piece therein. (See Reidinger, col. 4, lines 45-47; col. 5, lines 17-20). Therefore, Reidinger discloses a different arrangement than that of claim 12, specifically that a game piece is received in a recess in the lid, rather than affixed to a "raised central plateau." Thus, neither Strange nor Reidinger, alone or in combination, discloses or suggests this element of claim 12, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 12.

Claim 12, via claim 1, also includes, among other things, "said central plateau including a circumferential beveled segment over which a tab of the game piece may extend." As discussed above with respect to claim 1, Strange does not disclose or suggest this element. Applicants respectfully submit that Reidinger also does not disclose this element. First, Reidinger does not disclose any circumferential beveled segment. Indeed, the Examiner does not assert in the Office Action that Reidinger discloses or suggests such a structure. Also, as discussed above, the game

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piece (54) in Reidinger sits within the recessed well (44) and is covered by a sealing member (60). Therefore, it is impossible for any portion of the game piece (54) to extend over a circumferential beveled segment, even if one were present. Thus, neither Strange nor Reidinger, alone or in combination, discloses or suggests this element of claim 12, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 12.

Claim 13 depends from claim 12 and contains all the limitations of claim 12. Thus, for the reasons set forth above with respect to claim 12, the Examiner has not presented a *prima facie* case of obviousness with respect to claim 13.

Claims 15-22 and 25-27 depend from claim 14 and contain all the elements thereof, including, among other things, “a promotional game piece affixed to said lid so as to cover said recessed well in spaced relationship to said bottom wall thereof.” As discussed above with respect to claim 14, Reidinger does not disclose this element. Applicants also submit that Strange does not disclose this element. As discussed above, Strange does not disclose or suggest any use of game pieces or similar articles in connection with the disclosed lid. Therefore, Strange does not disclose or suggest this element of claims 15-22 and 25-27. Thus, neither Strange nor Reidinger, alone or in combination, discloses or suggests this element of claims 15-22 and 25-27, and the Examiner has not presented a *prima facie* case of obviousness with respect to claims 15-22 and 25-27.

Claim 28 includes, among other limitations, “affixing a promotional game piece to said annular upper wall such that said game piece covers said recessed well in spaced relationship to said bottom surface thereof.” Applicants respectfully submit that neither Strange nor Reidinger discloses this limitation of claim 28. As discussed above with respect to claim 14, the game piece (54) disclosed in Reidinger does not cover the recessed well (44). Rather, the game piece (54) is contained within the recessed well (44), which is covered by the sealing member (60). Additionally, because the game piece (54) of Reidinger is contained within the well (44), it cannot be affixed to an upper wall of said well (44). Therefore, Reidinger does not disclose this element of claim 28. As also discussed above, Strange does not disclose or suggest the use of a game piece in connection with the disclosed lid, so Strange does not disclose this element. Thus, neither Strange nor Reidinger, alone or in combination, discloses or suggests this element of

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claim 28, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 28.

Claims 29-35 depend from claim 28 and contain all the elements of claim 28. Thus, for the reasons set forth above with respect to claim 28, the Examiner has not presented a *prima facie* case of obviousness with respect to claims 29-35.

Rejections over Strange in view of Reidinger and Johnson

In paragraph 7 of the Office Action, the Examiner rejected claims 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Strange in view of Reidinger and further in view of U.S. Patent No. 5,746,312, to Johnson (“Johnson”). Claims 23 and 24 depend from claim 14 and contain all the elements thereof, including, among other things, “a promotional game piece affixed to said lid so as to cover said recessed well in spaced relationship to said bottom wall thereof.” As discussed above, neither Reidinger nor Strange discloses or suggests this element. Applicants also submit that Johnson does not disclose this element. Johnson discloses a flexible lid (14) comprised of two layers that seal together to form a cavity for containing a constituent (20) therein. (Johnson, col. 4, lines 10-23). This lid (14) is designed to be removed from the cup (10) so the liquid constituent (26) inside can be accessed. (Johnson, col. 4, lines 59-63). First, Johnson never discloses or suggests that the disclosed lid may be used with a promotional game piece. Further, it does not disclose a recessed well, as recited in the claims, or a game piece affixed to the lid to cover such a well. Indeed, the Examiner does not point to any disclosure of this element in Johnson. Thus, the proposed combination of references does not disclose or suggest this element of claims 23 and 24, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 23 and 24.

Motivation to Combine

Additionally, Strange is not properly combinable with Reidinger to form an obviousness rejection, nor are Strange and Reidinger properly combinable with Johnson to form an obviousness rejection. The law is clear that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention

would make the modification suggested by Examiner. “[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), citing *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). That motivation cannot come from the Applicant’s invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Thus, unless the references suggest the particular combination of elements themselves, they cannot render Applicant’s invention obvious. *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993). Moreover, it is the burden of the Examiner to show that the prior art relied upon contains such a suggestion or incentive. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Strange offers no motivation to use its disclosure to modify a lid according to the present invention because Strange is directed toward a completely different problem. As discussed above, Strange is directed entirely toward creating a stronger seal between the lid and the cup. (Strange, col. 1, lines 14-22). In fact, the entire center portion of the lid of Strange is largely ignored in the disclosure, since Strange is concentrated on the edge of the lid, where the sealing is accomplished. None of the central features of the lid are even assigned reference characters in the disclosure of Strange, and are referred to generically as the “dome” (12). (Strange, col. 2, lines 63-67 and FIG. 3). Finally, Strange does not disclose or suggest any use of a game piece or any similar article in connection with the disclosed lid. Thus, there would be no motivation for one skilled in the art to use the teachings of Strange to modify a lid to have a game piece affixed thereto.

Reidinger also offers no motivation to use its disclosure to modify a lid according to the present invention. While Reidinger is directed to coupling a game piece with a cup lid, both the nature of the game piece and Reidinger’s approach to solving the problem are different from that of the present invention. The game pieces in Reidinger are rigid, nonconformable game pieces designed to be separate from both the sealing member and the cup lid. (Reidinger, col. 1, lines 53-56). Such rigid, nonconformable game pieces would be difficult to use with the present invention. Additionally, the game pieces of Reidinger are loose, completely separate articles designed to be contained in a compartment within the lid. Reidinger is not directed to any

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arrangement where the article itself is affixed to the lid. Thus, there would be no motivation for one skilled in the art to use the teachings of Reidinger to modify a lid as claimed in Applicants' application.

Johnson further offers no motivation to use its disclosure to modify a lid according to the present invention. Like Strange, there is no disclosure or suggestion anywhere in Johnson that a game piece may be used in connection with the disclosed lid. Additionally, like Reidinger, Johnson is directed to containing a loose, completely separate article in a compartment within the lid, and not to an arrangement where the article itself is affixed to the lid. Thus, there would be no motivation for one skilled in the art to use the teachings of Johnson to modify a lid to have a game piece affixed thereto.

Accordingly, Strange, Reidinger, and Johnson provide no motivation or incentive to modify or combine their teachings, in any combination, to render the claimed invention obvious. Indeed, the Examiner has pointed to no such motivation or teaching in Strange, Reidinger, or Johnson. Thus, the Examiner has not met the burden to show that the cited references are properly combinable, and the Examiner's obviousness rejections are not proper.

New Claims

Applicants submit that new claims 36-38 are patentable over the prior art, including Strange, Reidinger, and Johnson, alone or in combination. Applicants respectfully request allowance of the same.

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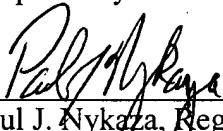
CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and allowance of claims 1-35. Applicants also respectfully request allowance of new claims 36-38. Applicants submit that the application is in condition for allowance and respectfully request an early notice of the same.

Respectfully submitted,

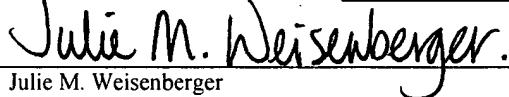
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CERTIFICATE UNDER (37 C.F.R. § 1.8a)

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